

The opinion in support of the decision being entered today was not written for publication and not binding precedent of the Board.

Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAIN ZANCO

Appeal No. 2003-0598
Application 09/172,830

HEARD: June 11, 2003

MAILED

JUN 18 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before COHEN, MCQUADE, and NASE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Alain Zanco appeals from the final rejection (Paper No. 29) of claims 1 through 3, 5, 8 and 9. Claims 7, 10 and 11, the only other claims pending in the application, stand withdrawn from consideration.

THE INVENTION

The invention relates to "a boot for a ski or in-line roller skate" (specification, page 1). Representative claim 1 reads as follows:

1. A boot for a ski or in-line roller skate, the boot having a sole with a heel portion and a front portion, the sole being connected to a flexible upper, wherein the sole has a first rigid part which extends forward from said heel portion over about one half of the length of the sole,

wherein the sole has a flexible portion which extends from the front portion rearward to the first rigid part so as to allow the foot to flex during walking, and

wherein the first rigid part includes an interlocking surface means which interlocks with a binding of an alpine ski or in-line roller skate thus firmly fixing the first rigid part against flexing with respect to the flexible portion.

THE PRIOR ART

The references relied on by the examiner to support the prior art rejections on appeal are:

Salzman	4,186,500	Feb. 5, 1980
Gladek	4,246,708	Jan. 27, 1981
Bourque	4,674,202	Jun. 23, 1987
Donnadieu	5,884,420	Mar. 23, 1999

THE REJECTIONS

Claims 1 through 3, 5, 8 and 9 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claims 1, 2 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bourque.

Claims 1 through 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gladek.

Claims 1 through 3 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Donnadieu.

Claims 5 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Donnadieu or Gladek in view of Bourque and Salzman.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 32 and 36) and to the examiner's answer (Paper No. 35) for the respective positions of the appellant and examiner regarding the merits of these rejections.¹

DISCUSSION

I. Petitionable matter

On pages 5 and 6 in the main brief, the appellant raises as an issue in the appeal the 37 CFR § 1.75(d)(1) objection to the specification set forth in the final rejection. As this matter is not directly connected with the merits of a claim rejection, it is reviewable by petition to the Director rather than by appeal to this Board (see In re Hengehold, 440 F.2d 1395, 1403-1404, 169 USPQ 473, 479 (CCPA 1971), and hence will not be further addressed in this decision.

II. The 35 U.S.C. § 112, second paragraph, rejection

The examiner considers independent claim 1 and dependent claims 2, 3, 5, 8 and 9 to be indefinite due to confusion as to

¹ The final rejection (Paper No. 29) contained additional rejections which have since been withdrawn by the examiner.

whether the "interlocking surface means" language in claim 1 constitutes a means plus function limitation invoking § 112, ¶ 6.² The examiner further submits that even if the limitation is interpreted to be in means plus function format as appears to have been intended by the appellant,³ it would still be indefinite because the underlying specification is not clear as to what structure this limitation encompasses.

The question of whether the "interlocking surface means" limitation in claim 1 is to be construed under § 112, ¶ 6, arguably affects the scope of the limitation. (In this case, however, it does not bear on the definiteness of the claim.) Although the limitation lacks literal support in the underlying specification as pointed out by the examiner, it clearly reads on any of the binding structures shown in Figures 3 through 14, all of which embody rigid part surface means adapted to interlock with a binding of an alpine ski or in-line roller skate. Thus,

² 35 U.S.C. § 112, sixth paragraph, states that

[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

³ See the remarks in Paper No. 27 accompanying the insertion of the word "means" into the limitation.

in either case, whether construed under § 112, ¶ 6, or not, the "interlocking surface means" recitation in claim 1, read as it is required to be in light of the underlying specification, sets out and circumscribes a particular area with a reasonable degree of precision and particularity.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 3, 5, 8 and 9.

III. The prior art rejections

Each of the prior art rejections on appeal rests on a finding by the examiner that the respective references applied in support of the rejections disclose boots meeting the "interlocking surface means" limitation in claim 1. Implicitly acknowledging that none of the references expressly describes such an interlocking surface means, the examiner predicates these findings on principles of inherency, i.e., on a determination that each reference discloses structure which is inherently capable of functioning as an interlocking surface means which interlocks with a binding of an alpine ski or in-line roller skate thus firmly fixing the first rigid part of the sole against flexing with respect to the flexible portion of the sole. Simply put, none of the applied references provides a reasonable factual

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basis for these findings. That is, none of the cross country ski boots disclosed by the applied references appears to have surfaces capable of interlocking with a binding on an alpine ski or an in-line roller skate.

Therefore, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claims 1, 2 and 8 as being anticipated by Bourque, the standing 35 U.S.C. § 102(b) rejection of claims 1 through 3 as being anticipated by Gladek, the standing 35 U.S.C. § 102(e) rejection of claims 1 through 3 and 9 as being anticipated by Donnadieu, or the standing 35 U.S.C. § 103(a) rejection of claims 5 and 8 as being unpatentable over either Donnadieu or Gladek in view of Bourque and Salzman.

SUMMARY

The decision of the examiner to reject claims 1 through 3, 5, 8 and 9 is reversed.

REVERSED

JEFFREY V. NASE
Administrative Patent Judge

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